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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,083	04/27/2001	Oliver Nickel	Beiersdorf 721-KGB	9696

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/13/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,083

Applicant(s)

NICKEL, OLIVER

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn.

Response to Amendment

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that the newly amended claim 1 is replete with vague, indefinite and confusing structural relations and phrases. For example, at lines 2-3, the claim lacks the structural relation between the sheet backing and adhesive composition. Also, throughout claim 1, the structural relations between the adhesive tape, the masking material and the masking sheet are not provided either. Further, at lines 4-5 and 8-9, there is no antecedent basis for "an edge region", and it is not clear to the Examiner how a "adhesive composition" could have "an edge region". Lastly, at line 10, there is no antecedent basis for "on a side".

In claim 7, line 2, the term "dimensions" is vague and indefinite, the Examiner suggests replace it with a more suitable term, such as --surface--.

In newly added claim 11, line 2, the phrase "fine line tape" is vague and indefinite, i.e., it is not clear to the Examiner the range of "fine line".

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4. With respect to Applicant's comment that the previous Office Action should not be made final due to new ground of rejection under 35 USC 112 (Response, page 3, second paragraph), the Examiner apologizes that the Office Action Summary of the previous Office Action was inadvertently marked as final. However, the Official record is non-final. Further, the aforementioned rejection is now corrected (section 4 of this Office Action). As such, it is believed that the error in the previous Office Action has caused no harm to the Application.

5. With respect to Applicant's Response arguing that claim 1 on page 6 of the original application does specify the claim number (Response, page 3, paragraph 4), the Examiner reiterates that the claim number of presumed claim 1 is missing from the original application. Nevertheless, the Examiner has made correction on the record.

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1-3, 5-7, 10, 13-15, 17 and 19-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 2-9, 11 and 12 of

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compending Application No. 09/431849. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

With respect to the newly amended claim 1, it is believed that the limitations of claim 1 are encompassed by claim 12 of Application No. 09/431849, except the newly added recitation of "said masking material being capable of adhering to paint and of absorbing paint". However, these aforementioned limitations are believed to be inherently disclosed by claim 12 of Application No. 09/431849, which discloses a masking material being paper.

Claims 2, 3, 5-7, 9 and 10 are the same inventions as claims 2, 3, 5-7, 9 and 11 of Application No. 09/431849, respectively. The limitation in newly added dependent claim 17, i.e., corona pretreated, is found in claim 6 of Application No. 09/431849. Further, newly added claims 13-15 are encompassed by claims 3, 5 and 6 of Application No. 09/431849, respectively, and newly added method claims 19 and 20 are found in method claim 11 of Application No. 09/431849.

8. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-9, 11 and 12 of compending Application No. 09/431849. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 2-9, 11 and 12 of compending Application No. 09/431849 are again relied upon as set forth above. For claims 1-3, 5-7, 10, 13-15, 17 and 19-20, if the reference is not considered to be an anticipation under statutory double patenting, in the absence

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of unexpected results, the Examiner believes that, alternatively, each of the claimed embodiments is at most a minor modification to one of ordinary skill.

With respect to newly amended claim 4, although U.S. Application No. 09/431849 does not expressly claim "woven fabric, nonwoven fabric and other sheet material capable of adhering", it is noted that Application No. 09/431849 discloses in b) of claim 12 a "masking paper" being masking material. As such, it would have been obvious to one of ordinary skill in the art to substitute "masking paper" with "woven fabric, nonwoven fabric and other sheet material", motivated by the desire to adsorb and adhere the paint.

For newly amended claims 8 and 18, it is noted that claim 8 of Application No. 09/431849 teaches that the marginal area of the self-adhesive composition is 1-5 mm wide, and it is believed to be within the skill of the art to apply the same width to both masking material and masking sheet.

For newly added claims 11, it is believed that Fig. 1 of Application No. 09/431849 discloses a heat-resistant tape with narrow width.

For newly added claim 12, it is believed that polypropylene and PVC are old and well known materials for adhesive tape backing.

For newly added claim 16, it is believed that polyethylene is an old and well known material for masking sheet.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC
February 11, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~

1700

Daniel Zinker